

REMARKS

The Office Action

Claims 1-5 and 8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,109,991 to McPherson, et al. (hereinafter merely referred to as McPherson) in view of U.S. Patent No. 5,855,480 to Housman.

Claims 6-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McPherson in view of Housman and further in view of U.S. Patent No. 5,449,202 to Nalepka, et al. (hereinafter merely referred to as Nalepka).

Claims 9-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over McPherson in view of Housman.

Summary of Amendments to the Abstract

In accordance with the reminder in the outstanding Office Action, the abstract has been amended to alter the language and/or format so as to better comport with accepted practice. However, Applicant is unable to comply with the requirement in the Office Action that the term “comprise” be replaced inasmuch as the abstract contains no such term.

Summary of Amendments to the Claims

Claims 4 and 6 have been amended as suggested in the outstanding Office Action. Accordingly, it is respectfully requested that the objections thereto now be withdrawn.

Claims 5 and 12 have been amended to clarify how the wallcovering samples are rotated.

Background

The present application is directed to a system and/or method for organizing and displaying a plurality of different wallcovering samples. In particular, samples are sorted and stacked into separate books or decks based upon the particular color characteristics of the individual samples, e.g., the predominate hue of each sample. Accordingly, for example, one book or deck may contain a set of samples where each one has a predominately green hue, but with a variety of different patterns, finishes, constructions,

etc.; while another book or deck may contain a set of samples where each one has a predominately blue hue, but with a variety of different patterns, finishes, constructions, etc; and so on for each distinct or separate hue. Suitably, each book or deck is arranged so that one or more individual samples can be easily rotated or fanned out from the rest of the samples in the stack. Notably, the present approach represents a significant departure from conventional prior art approaches, and realizes practical advantages over these prior art approaches.

Traditionally, wallcovering sample books are presented and/or organized according to pattern. That is to say, one book typically contains samples representing all the different color variants for a single pattern; while a second book contains samples representing all the different color variants for another single pattern; and so on for each pattern in the collection. This conventional and long standing practice of grouping wallcovering samples according to pattern, however, is not always conducive or beneficial to the design or wallcovering selection process.

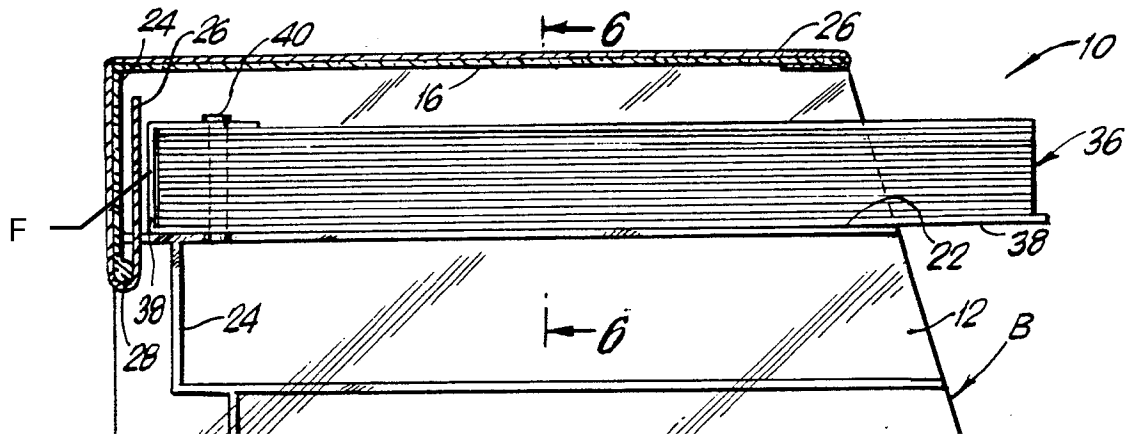
For example, the Applicant has discovered that a consumer or designer shopping for wallcovering often wants to match the “correct” color of the wallcovering to the environment in which it will be used. That is to say, in the wallcovering selection process, often color is a relatively higher priority as compared to pattern. Accordingly, by grouping samples of like color together, the decision making and/or selection process is advantageously streamlined. That is to say, the designer or consumer need not look through a variety of different pattern books each having an array of color choices to find all the patterns in a desired color – rather they may simply look through the one book having the desired color and select a particular pattern therefrom.

The McPherson Patent

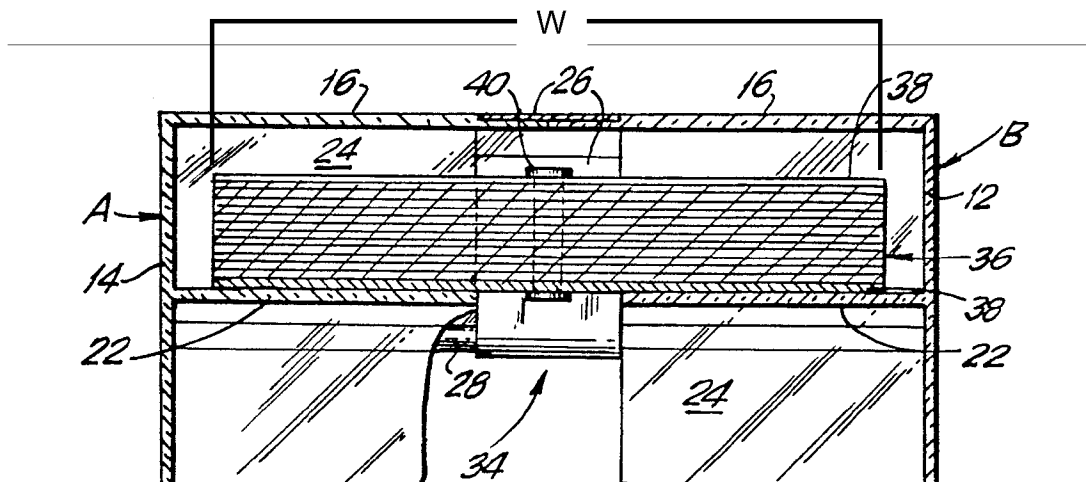
McPherson is directed to a storage container for wallcovering sample books. Significantly, McPherson does not disclose any particular organization method for the wallcovering samples. Nowhere does McPherson describe what kind of samples are held in each individual book or how the samples are sorted into the books.

Additionally, the book **36** disclosed by McPherson is a “flip” book as opposed to a “fan” deck which is employed in the present application. As shown in FIGURES **5** and **6**, the

spine **38** of the book **36** completely wraps around one end of the stack of samples. In the detail from FIGURE 5 reproduced below, note that the spine **38** has a vertical face (labeled with the reference character **F**) that abuts the ends of the stacked wallcovering samples.



Moreover, as seen in the detail from FIGURE 6 (reproduced below), the spine **38** extends the entire width (labeled with the reference character **W**) of the stacked wallcovering samples.



Accordingly, the upper samples in the book **36** must be flipped up and typically held up in order to view underlying samples. Furthermore, due to the flip book arrangement, it is only convenient to have one underlying sample at a time revealed. In any event, the face **F** of spine **38** abutting the ends of the stacked samples constrains the samples and prevents

them from being fanned out. That is to say, the samples cannot be rotated about the fastener **40** in a plane substantially normal to the fastener **40**.

The Housman Patent

The Housman Patent is directed to a storage unit for wallcovering sample cards. Notably, Housman only disclose a single unit in which all the wallcovering samples are stored. Nowhere does Housman suggest that samples be sorted into separate distinct books or decks. That is to say, in accordance with the teachings of Housman, all the samples are held in a single unit, including samples of varying color characteristics. Housman simply does not teach storing samples of different colors in different units. Rather, Housman teach exactly the opposite – namely, storing a plurality of samples having varying colors in the same unit. Accordingly, the teaching of Housman is directly contrary to the approach of the present application, which is directed to sorting and holding samples of different colors in separate and distinct books or decks. That is to say, in the present application, a plurality of separate and distinct decks are used to hold a plurality of samples having different color characteristic, with each deck holding multiple sample exhibiting the same color variant. Conversely, in accordance with Housman, a single unit holds a plurality of samples exhibiting an array of different color variants.

The Nalepka Patent

Nalepka is directed to a method and apparatus using a complex color coded scheme in connection with the shelving of library books or audio/visual media. Significantly, Nalepka is non-analogous art. That is to say, the invention of Nalepka deals with library books and audio/visual material not wallcovering samples.

Moreover, the method of Nalepka uses the color coding as indicia to represent alphanumeric characters. The color coding has no rational relationship to any type of color content contained within the marked item. Rather, the color coding merely allows an observer to notice when an item is misfiled on an otherwise alphabetically arranged shelf, e.g., when an title beginning with a blue “b” is positioned between two titles beginning with a red “r”.

The Present Claims Distinguish Patentably over the Prior Art

With respect to the rejection of claims 1-5 and 8, the rejection is hereby traversed. Significantly, claim 1 calls for “a plurality of wallcovering samples, each sample having a color characteristics; and, a plurality of sample holders, each holder being dedicated to a different color group and configured to hold a set of the samples.” As claimed, “the samples are organized into the holders based upon their respective color characteristics such that each holder holds a set of samples having like color characteristics.” Neither McPherson nor Housman (either alone or in combination) teach the foregoing. Moreover, the motivation provided for the combination fails to make a *prima facie* case for obviousness.

As claimed, the samples are organized into a plurality of different holders based upon their color characteristics such that each holder which is dedicated to a different color group contains a set of sample with like color characteristic. As conceded in the Office Action, McPherson does not disclose any sort of organization scheme. Additionally, Housman teaches that a single unit or holder contains a plurality of samples having a varying array of different color characteristics. Accordingly, neither reference teaches the claimed subject matter. Moreover, by combining the teaches of Housman with McPherson, at best, each resulting book **36** of McPherson would still hold a plurality of samples with a varying array of different color characteristics as taught by Housman.

Accordingly, insomuch as both McPherson and Housman fail to teach each and every claimed feature, it is respectfully submitted that claim 1 distinguishes patentably over the references, along with claims 2-8 depending therefrom.

The alleged motivation for combining the references is “that it is well known to group colored samples by color characteristic.” However, this motivation is improper and fails to make a *prima facie* case for obviousness, as is the Examiner’s burden. Accordingly, it is respectfully submitted that rejection should be withdrawn. In this regard, the Manual of Patent Examining Procedure (MPEP) is instructive. According to MPEP §2144.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The pertinent question to be answer by the alleged motivation is not can one combine the reference, but why would one want or desire to combine the reference. The motivation provided in the Office Action does not answer this fundamental question.

Furthermore, MPEP §2144.01 also states that the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” More specifically, even if the combined references individual teach all of the aspects of the claimed invention, this alone is not sufficient to establish a *prima facie* case of obviousness unless there is some objective reason to combine the teachings. The Office Action presents no such object reason to combine the teaching of Housman with McPherson. Rather, the Office Action merely alleges that it is well known to group colored samples by color characteristic.

Additionally, the Examiner provides no suitable support for the obviousness rejection. That is, the motivation for any proposed combination is not expressly recited in the prior art. The Examiner’s statements in this regard simply lack any supporting evidence in the record. Again, the MPEP is instructive on this point. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP §2143.01. Neither McPherson nor Housman expressly provides the motivation for making the proposed combination. As explicitly recited in the Office Action, however, the Examiner is relying on what is well-known or common knowledge in the art.

Surely, the Examiner is well aware that the Applicant is required to seasonably challenge statements by the Examiner that are not supported by evidence on the record, and that failure to do so will be construed as an admission by the Applicant that the statements are true. See, e.g., MPEP §2144.03. Therefore, in accordance with the Applicant’s duty to seasonably challenge such unsupported statements, the Examiner is respectfully requested to cite one or more specific references that provide evidence of the alleged common knowledge in the art. Compliance with MPEP §2144.03 mandates that if an Examiner is to properly maintain a rejection then documentary evidence must be supplied when the Applicant traverses the Examiner’s assertions with respect to what is well-known or common knowledge in the art. Alternately, if the Examiner is unable to provide the required evidence by way of a cited reference, and is instead relying on their own personal knowledge, Applicant hereby requests that the evidence be provided in the

form of an affidavit from the Examiner under 37 C.F.R. §104(d)(2). Absent substantiation on the record by the Examiner, it is respectfully requested that the rejection of claims 1-5 and 8 under 35 U.S.C. §103(a) be withdrawn.

The rejections of claims 5 and 12 are also traversed. In particular, claim 5 recites that “individual samples are selectively rotatable about the pin in a plane substantially normal to the pin.” As previously pointed out, McPherson discloses a “flip” and not a “fan” deck. In the book **36** disclosed by McPherson, the samples are flipped up, not rotated about the fastener **40** in a plane substantially normal to the fastener **40**. Similarly, claim 12 recites that “individual samples are selectively rotatable with respect to one another about a common axis, said common axis being substantially normal to the samples’ faces as they are stacked atop one another.” In the book **36** disclosed by McPherson, the samples are not rotated about a common axis that is substantially normal to the faces of the samples. Rather, by flipping the samples up, at best it can be said that the samples rotate about an axis which is parallel to the faces of the samples.

The rejection of claims 9-16 is also traversed. Significantly, claim 9 recites “sorting the samples into sets having like color characteristics.” Again, McPherson fails to disclose any particular method by which the samples are sorted, and Housman teaches a single unit that holds a plurality of samples with a varying array of different color characteristics. Nowhere does Housman even suggest sorting the samples into different sets, let alone sorting them according to their color characteristics.

Accordingly, it is respectfully submitted that claim 9 distinguishes patentably over the prior art along with claims 10-16 that depend therefrom.

CONCLUSION

For the reasons detailed above, it is respectfully submitted that all the claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination. In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to telephone the below signed at the telephone number listed.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

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Date

/John P. Cornely/

John P. Cornely, Reg. No. 41,687
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582